

REMARKS

In the Final Office Action, the Examiner finally rejected claims 1-33 and 36-59. By the present response, Applicants amended claims 1, 20, 31, 32, 43, 45-47, and 51 to clarify certain aspects of the claimed subject matter. Specifically, the Applicants clarified the nature of the footprints recited in each of the independent claims 1, 20, 32, 43, and 51. For example, independent claims 1 and 51 now recite that the footprints are adapted to rest on a supporting surface, independent claim 20 recites that the footprints are adapted to contact a supporting surface, and independent claims 32 and 43 recite that the footprints are adapted for support on a surface. Applicants stress that these amendments do not alter the scope of the present claims and, thus, do not necessitate a new search. Accordingly, the Applicants respectfully request that the Examiner enter these amendments and reconsider the present application in view of the following remarks.

Objections to the Drawings Under 37 C.F.R. § 1.83(a)

The Examiner objected to the drawings for failing to show every feature of the invention specified in the claims. Specifically, the Examiner argued that the drawings do not show the angular lock assembly recited in claim 13. By this paper, the Applicants amended the specification to provide a reference to the angular lock assembly recited in claim 13. As amended, FIG. 4 illustrates an angular lock and latch release 195, which the specification describes at page 13, lines 4-18. For these reasons, Applicants request that the Examiner withdraw the objection under 37 C.F.R. § 1.83(a).

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-59 under U.S.C. § 112, Second Paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. Specifically, the Examiner objected to the terms “base footprints,” “support footprint,” “bottom mounting footprints,” “structural footprints,” and mounting contact footprints” recited by independent claims 1, 20, 32, 43, and 51, respectively. Although Applicants disagree with the Examiner’s rejection, the Applicants removed these terms in favor of alternative claim recitations that the footprints are *adapted to*

rest on a supporting surface, adapted to contact a supporting surface, or adapted for support on a surface. Applicants believe that these claim amendments more clearly recite the nature of the footprints without changing the scope of the instant claims. In view of the foregoing amendments and remarks, Applicants respectfully request withdrawal of the rejections under Section 112, Second Paragraph.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1-7, 11-17, 20-24, 27-33, 36-47, 49-56, 58, and 59 under 35 U.S.C. §102(b) as anticipated by Helot et al..

Legal Precedent

First, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Second, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or

technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (CCPA 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

Third, the *drawings* of the cited reference must be evaluated for what they *reasonably disclose and suggest* to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 U.S.P.Q. 500 (CCPA 1979).

Independent Claims 1, 20, 32, 43, and 51

As noted above, the amended independent claims 1, 20, 32, 43, and 51 recite multi-sectional structures configurable with multiple *footprints*, which are *adapted to rest on a supporting surface* (claims 1 and 51), *adapted to contact a supporting surface* (claim 20), or *adapted for support on a surface* (claims 32 and 43).

Examiner’s Detailed Rejection

In the Office Action, the Examiner specifically stated:

Regarding claim 1, Helot discloses the (Fig. 1-3) a computer system (20) comprising: a component housing comprising: a first section (22); and a second section (42) rotatably coupled to the first section (22); a third section (54, 56) rotatably coupled to the second section (42), wherein the first, second, and third sections are rotatable between a plurality of

configurations having *different footprints (Fig. 2, 3)* and at least two of the first, second, and third sections are adapted to house components (i.e. section (22) houses keyboard (21) and section (42) houses components of the hinge assembly (27)); and a display (28) rotatably coupled to the component housing.

Paper 15, page 4 (emphasis added). Thus, the Examiner equated the different footprints recited in claim 1 with Figures 2 and 3 of Helot. In addition, the Examiner equated the reduced footprint of claim 20, the at least two different footprints of claim 32, the plurality of footprints of claim 43, and the plurality of different footprints of claim 51 with Figures 2 and 3 of Helot. See Paper 15, pages 5-7.

In response to the applicants' previous arguments, the Examiner stated:

The Examiner would like to reiterate that the footprint of the computer as depicted on Fig. 3 of Helot et al. is larger than the footprint as depicted on Fig. 2 or Fig. 1 or Fig. 4-7. Also, the Examiner believes that applicant is in error while considering that footprint of the Helot computer is only produced by portion (22). The Examiner believes, that the *footprint is also produced by the projection* formed by portion (42) on a supporting surface. Thus, since portion (42) is rotatable, it will produce a *variable projection* on the supporting surface. Therefore, the total footprint of the computer will be also variable as shown on Fig. 2 and 3 of Helot et al.

Paper 15, pages 10-11 (emphasis added).

Deficiencies of Helot

In view of the present claims and the Examiner's arguments, the Applicants respectfully stress that Helot et al. is absolutely devoid of multiple footprints adapted to rest, contact, or support on a surface, as recited in each of the independent claims 1, 20, 32, 43, and 51.

Clearly, the Examiner's position is that a footprint includes a projection or shadow of a structure, rather than positioning of the actual structure on a surface. However, the Applicants have repeatedly stressed that a footprint is not a mere shadow or projection from a

structure, as suggested by the Examiner. *See* Paper 14, Pages 12-16. In the previous Response to Office Action, the Applicants amended the claims to clarify this nature of the footprints by qualifying the term footprints with adjectives, such as the base, support, structural, and mounting contact. *See* Paper 14, Amendments to Claims 1, 20, 32, 43, and 51. However, instead of recognizing the Applicants' clear intent of these clarifying amendments, the Examiner unreasonably rejected the claims under 35 U.S.C. § 112, second paragraph.

First, Applicants stress that a *footprint* is defined as a "mark left by the shod or unshod foot, as in earth, sand, etc." or an "impression of the sole of person's foot." THE RANDOM HOUSE COLLEGE DICTIONARY 514 (REV. ED. 1988). Clearly, this definition does not include a projection or shadow, as suggested by the Examiner.

Second, by this paper, the Applicants amended the independent claims 1, 20, 32, 43, and 51 to recite the footprints as *adapted to rest, contact, or support* on a surface. If the Examiner is unmoved by the clear definition of a footprint, then this functional language clearly indicates the scope of the claimed footprints. Therefore, the Applicants reiterate that a *projection* is not adapted to rest, contact, or support on a surface.

Third, the Helot et al. reference is absolutely devoid of any teaching or suggestion of different footprints. In contrast, Helot et al. discloses only *one invariable base 22* mountable on a surface. *See* Helot et al., Figs. 1, 8, 10, 11. In fact, the Helot et al. reference never even mentions the term footprint, much less multiple different footprints. Regarding the Examiner's argument about the *projection* from the arm member 42, the Applicants stress that the arm members 42 and 52 serve nothing more than a means of positioning the display 28. *See* Helot et al., Figs. 1-12; Abstract; Summary; Col. 2, lines 35-44 and 66-67; Col. 3, lines 1-25. In all of the different spatial positions of the arm members 42 and 52, the base 22 is the only structure actually mounted on a surface. *See id.* Applicants also submit that the configuration and location of the pivot mechanism 27 prevents the arm member 42 from ever contacting, resting, or supporting on a surface. *See* Helot et al., Figs. 4-7. Therefore, the Helot reference fails to teach or suggest different footprints, as recited by the instant claims.

Fourth, the Helot et al. reference clearly lacks multiple component housing sections, as recited in the instant claims. Turning to Helot et al., the only portion of the computer 20 adapted to house components is the computer base 22. *See* Fig. 3 and col. 4, lines 24-26. In the Office Action, the Examiner equated the computer base 22 and the first arm member 42 to the housing sections recited in the instant claims. *See* Paper 15, pages 4 and 5. For example, the Examiner argued that arm section 42 houses components of the hinge assembly 27. *See id.* First, the Applicants stress that Helot et al. do not disclose the arm section 22 as *housing* the hinge assembly 27, but rather the hinge assembly 27 provides an *intermediate connection* between the arm section 22 and the computer base 22. *See* Helot et al., Col. 2, lines 38-40 and 58-60. Second, the hinge assembly 27 is not a *component* as described in the present application and recited in the instant claims. For example, the application specifically lists the following example components: “a battery, a power supply, a disc drive, a hard drive, ram memory, a processor, a CD Rom drive, a CD-RW drive, a DVD Rom drive, a DVD Ram drive, a DVD-R drive, a DVD-RW drive, a tape drive, a communication device (e.g., a modem, a network card, wireless technology, blue tooth technology, etc.), and various other circuits and electronic components for the computing device 10.” Application, Page 5, line 21 – Page 6, line 4. Although Applicants contemplate other computer components, a hinge assembly is not reasonably within the scope of such components. Therefore, the Helot reference fails to teach or suggest multiple component housing sections, as recited by the instant claims.

In view of these missing elements, independent claims 1, 20, 32, 43, and 51 and their respective dependent claims are believed to be patentable over Helot et al. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102 and allow the foregoing claims.

Rejections of Dependent Claims Under 35 U.S.C. § 103

The Examiner rejected *dependent* claims 8-10, 18, 25, 26, and 57 under 35 § U.S.C. §103(a) as unpatentable over Helot et al. in view of Karidis (U.S. Patent No. 6,006,243). The Examiner also rejected dependent claims 19 and 48 under 35 § U.S.C. §103(a) as

unpatentable over Helot et al. in view of Stern (U.S. Patent No. 5,260,884). Applicants respectfully traverse the Examiner's rejections.

Legal Precedent

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (P.T.O. Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002).

Second, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Third, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art

would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01.

Deficiencies of the Cited References

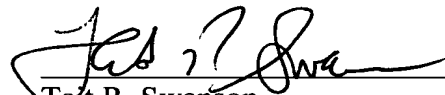
Applicants respectfully traverse the foregoing rejections for a number of reasons. First, all of the claims subject to this rejection under 35 U.S.C. § 103 are dependent on one of independent claims 1, 20, and 51, which are believed to be patentable over the Helot et al. reference for the reasons set forth above. Second, neither Karidis nor Stern obviates the deficiencies of Helot et al. For example, none of the cited references teach or suggest a plurality of *footprints adapted to rest, contact, or support on a surface*, as recited by the foregoing independent claims. Accordingly, the foregoing dependent claims 8-10, 18, 19, 25, 26, 48, and 57 are believed to be patentable over the Helot et al., Karidis, and Stern references taken alone or in combination. For these reasons, Applicants respectfully request that the Examiner withdraw the rejections of claims 8-10, 18, 19, 25, 26, 48, and 57 under 35 U.S.C. § 103.

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Applicants kindly invite the Examiner to contact the undersigned attorney at the telephone number indicated below.

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Respectfully submitted,


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